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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/675,025 | 09/28/2000 | Charles Eric Hunter | WT-10 | 7653 |

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| EXAMINER | |
|---|---|
| REILLY, SEAN M | |
| **ART UNIT** | **PAPER NUMBER** |
| 2153 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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| 3 MONTHS | 04/19/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/675,025 | HUNTER ET AL | |
| | Examiner | Art Unit | |
| | Sean Reilly | 2153 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *01 February 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *134,135,137-147,149-169 and 171-176* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *134-135, 137-147, 149-169, and 171-176* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

This Office action is in response to Applicant's amendment and request for reconsideration filed on December 14, 2005 and the request for information response filed on February 1, 2007. Claims 134-135, 137-147, 149-169, and 171-176 are presented for further examination. All independent claims have been amended.

### *Response to Arguments*

Applicant's arguments are moot in view of the new grounds of rejection set forth below. Notably Examiner has applied Beach to teach automatically overwriting stored digital content with automatically selected video programs according to a defined criteria.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**1. Claims 158-167 and 175-176 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

With regard to claims 158-167 and 175-176, these claims recite various *mechanisms* that may be implemented solely in software and are thus software per se. As recited in the interim guidelines pg 53 "computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical 'things.' They are neither computer components nor statutory processes, as they are not 'acts' being performed" (Interim Guidelines for

Examination of Patent Applications for Patent Subject Matter Eligibility" signed October 26th, 2005). No "acts" are performed because the "claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized." Thus, claims 158-167 and 175-176 are directed to non-statutory subject matter. Applicant may overcome this rejection by embodying the claimed computer programs on a computer readable storage medium.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**2. Claims 134-135, 137-140,145, 146-152, 158-160, 165-167, 168-169, and 171-177 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo (U.S. Patent 6,025,868) and Graves et al. (U.S. Patent Number 5,410,344; hereinafter Graves) and Beach et al. (U.S. Patent Number 6,728,713; hereinafter Beach).**

As per claims 134 and 146, Russo teaches a method comprising:

transmitting plural digital content the customer [inherent];

permitting the customer to select desired content for recording [see coi.4 lines 15-25 - optical discs];

Russo suggested making use of program schedule information from a provider (coi.4 lines 63-65). However Russo does not specifically disclose providing classification information in a header and automatically selecting video programs based on degree of similarity with a customer preference. In similar field of video transmission, Graves teaches transmitting classification information in a header of at least some of the plurality of the video programs (coi.4 lines 10-21, 53-59); providing mechanism to compare the classification information to preference information of a consumer location (coi.4 lines 22-51); and providing mechanism to automatically select video programs having a defined degree of similarity between the classification information and the preference information (coi.4 lines 31-35, coi.7 lines 55-62). Hence, it would have been obvious for one of ordinary skill in the art to combine the teaching of Graves with Russo because it would have improved the system by providing an adaptive system for selecting programs that fits the preferences of individual viewers (Graves coi.2 lines 3-11).

Russo also failed to specifically recite automatically overwriting stored digital data content with the automatically selected video programs according to a defined criteria. In a similar field of video transmission, Beach disclosed selecting video programs having a defined degree of similarity (inferred preferences or fuzzy recordings) and automatically overwriting stored digital data content with the automatically selected video programs according to a defined criteria (e.g. overwriting already viewed programs no longer interesting; also see ongoing flushing old programs and addition of new programs to ensure programming of interest to the user; note "no program is removed until another program is recorded in its place," see inter alia Col 18, lines 44-61). Beach further disclosed that it is important to overwrite old content with new content in order to ensure the that storage area is always full of programming of interest to

the viewer (Beach, Col 18, lines 57-60). Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Russo's system to automatically overwriting stored digital data content with the automatically selected video programs according to a defined criteria such as deleting old content, as disclosed by Beach, in order to ensure the that storage area is always full of programming of interest to the viewer (Beach, Col 18, lines 57-60).

As per claim 135 and 147, Russo teaches billing the customer once a video program has been selected for viewing that has been previously recorded [coi.5 lines 1-5, coi.6 lines 25-32, col.ll lines 57-59].

As per claims 137-138 and 149-150, Beach disclosed the defined criteria is that oldest stored video programs or the older releases of stored video are overwritten with the automatically selected video programs (Beach see inter alia Col 18, lines 44-61).

As per claims 139 and 151, Beach disclosed the defined criteria is that stored digital data content which least fits a preference of the consumer location is overwritten with the automatically selected video programs (e.g. the inferred preferences of the viewer or viewers, Col 18, lines 54-57).

As per claims 140 and 152, Russo teaches recording desired content on removable storage medium [see coi.4 lines 15-25 -optical discs].

As per claim 145, Russo teaches transmitting via satellite (coi.6 lines 16, coi.8 lines 19-23, coi.9 lines 20-33).

As per claims 158, 168, and 175, they are rejected under similar rationale as for claim 134 above.

As per claims 159 and 174, they are rejected under similar rationale as for claim 140 above.

As per claims 160, 169 and 176, they are rejected under similar rationale as for claim 135 above.

As per claims 164-167, 171-173, and 177 they are rejected under similar rationales as for claims 136-139 above.

**Claims 141 and 153 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo, Graves, and Beach and further in view of Rabowsky US patent 6,141,530.**

As per claims 141, and 153, Russo teaches, Russo does not teach preventing playback on an unauthorized device. However, in similar field of content transmission, Rabowsky teaches Control Assess Systemto encode the content so as to permit only playback on authorized device (see coi.6 lines 5-23, coi.6 line 58 to coi.7 line 4). Hence, it would have been obvious for one of ordinary skill in the art to combine the teaching of Rabowsky with Russo because it would have improved the security of the system and reduced pirating.

**Claims 142-144, 161-163 and 154-156 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo, Graves, Beach, and Rabowsky, and further in view of Banker et al. US patent 6,005,938.**

As per claims 142-143, 161-162 and 154-155, Russo as modified does not teach encoding the movie with a time-based code keys. In similar field of invention, Banker teaches a method of encryption including encrypting with time-based code keys and transmitting keys to the users to enable playback at during certain period of time and prevent authorized uses (see Abstract, fig.2, col.l lines 37-63, coi.4 lines 7-53). Hence, it would have been obvious for one of ordinary skill in the art to combine the teaching of Banker to Russo to encode the movie with a time-based code keys because it would have improved the security of the system. Banker' teaches transmit a correlated key B to all customers and a time-based key C that are provided to customers who are in good standing. (See Banker coi.6 lines 55-68 and Russo coi.6 lines 15-21, 50-53.)

As per claims 144, 163 and 156, Russo teaches communicate playback information to the central controller when time based code C are provided (coi.6 lines 25-27).

***Conclusion***

3. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 5, 2007

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